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10/591,660	09/05/2006	Yousuke Yamada	R2184.0529/P529	1441
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DICKSTEIN SHAPIRO LLP			EXAMINER	
1825 EYE STREET NW			PSITOS, ARISTOTELIS M	
Washington, DC 20006-5403				
		ART UNIT	PAPER NUMBER	
		2627		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/591,660

Applicant(s)

YAMADA, YOUSUKE

Examiner

Aristotelis M. Psitos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The IDS documents submitted have been reviewed to the extent they are in English – i.e., abstracts only. As such they have been made of record.

Errata

The following analysis/groupings of the claims are presented by the examiner:

Group a) Apparatus claims for recording and associated method claims, cls 1-5 and 7-11.

Group b) Apparatus claims for reproducing and associated method claims, cls 6 and 12.

Although these claims are presented in dependent form, they are (see below) objected to and interpreted as independent claims. If this is incorrect, then further response is required from applicants as to what exactly these claims are attempting to define.

Group c) Intermittent recording apparatus and associated method claims, claims 19-38.

Group d) Claims drawn to a computer - readable medium and the functioning thereof, claims 13-18.

Group e) Claims drawn to a program, claims 39-48.

Claim Objections

Claims 6 and 12 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In particular, these are presented as dependent claims, however, they fail to properly further define their respective parent claim, i.e., they attempt to broaden their respective parent claim. Proper correction and presentation is required.

If applicants do intent these claims to be dependent claims, applicants statement is of such is required and furthermore these claims would be rejected under 35 USC 112 paragraph two as failing to particularly point out the invention as attempting to redefine a recording apparatus and method in terms of reproduction in any subsequent OA.

Claim Rejections - 35 USC § 101

1. Claims 39-48 are rejected under 35 U.S.C. 101 because they are drawn to a "computer program" per se, therefore, fail to fall within a statutory category of invention.

A Claim/s directed to a computer program itself is non-statutory because it is not:

A process occurring as a result of executing the program, or

A machine programmed to operate in accordance with the program, or

A manufacture structurally and functionally interconnected with the program in a manner which enable the program to act as a computer component and realize its functionality, or

A composition of matter.

See MPEP § 2106.01. Data structures not claimed as embodied in computer readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g. *Warmerdam*, 33 F.3d at 1361, 31 USPQ2nd at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs are not physical things. They are neither computer components nor statutory processes, as they are not acts being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
2. Claims 1-3, 7-9, 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 08-214253.

Applicant's attention is drawn to the accompanying MAT (machine assisted translation) of the JP document. These claims are relied upon for the reasons stated in the submitted search report, i.e., paragraphs 11-28 and as amplified below.

As noted in the MAT, both a recording and reproducing system and method are discussed. Furthermore, compression of the data is performed as well as address information, frame information and time information associated with such encoding of the information. Appropriate storage of such

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information in various locations across a computer readable medium/optical disc is also discussed. The index data is appropriately appended to the compressed data as claimed.

3. Claims 4-6,10-12,16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims as stated above in paragraph 2, and further in view of JP 2001-69447.

As stated in the submitted search report as noted with respect to paragraphs 12-35, this secondary reference discloses the above claimed subject matter, especially wrt the ability of recording to another medium, as well as the various speeds of reproducing.

4. Claims 19-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honda/or JP 2002-77803 further considered with the above noted JP 8-214253 system.

Independent claim 19 (and associated method claim 29) differ from claims 1 and 7 in that they include an "intermittently" recording limitation.

As noted in the submitted search report, JP 2002-77803 – see in particular the identified paragraphs – or alternatively US patent to Honda (see the description starting in col. 3 line 25 and continuing till the end) of an intermittent recording capability in this environment.

There is no clear depiction of the recited "index" Information, nevertheless such index information must inherently exist, and else no retrieval of any of the information would be possible. Furthermore, such index capabilities are well known as further taught/disclosed by the above noted JP 8-214253 system, e.g. also with respect to the time and frame information of dependent claims 22,23,25,32,33,35.

With respect to claims 24, 26, 34 and 36 such are met by the operation of the overall systems.

With respect to claims 27, 28, 37 and 38, the examiner interprets the operation with respect to the dram as meeting such.

It would have been obvious to modify the base system of either Honda/JP 2002-77803 with such additional teachings motivations so as to access the information at a subsequent time.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Jp 2002-77803 also teaches both the index (thumbnail) and intermittent recording capability and can be relied upon for meeting the above noted claims including such limitations – as further specified in the submitted search report. The MAT (machine assisted translation) of such document is provided for the benefit of applicants US representative.

.JP 2001-320700 also discloses the desired frame/time information as index and can also be relied upon for meeting such claimed limitations as further specified in the submitted search report. The MAT (machine assisted translation) of such document is provided for the benefit of applicants US representative.

Applicant's attention is also drawn to Ota (cited by applicant) - the system meets the limitations of claims 1-3 and associated method claims.

Applicant's attention is also drawn to Yokota et al – see the discussion starting at col. 15 lines 19 plus and continuing till col. 19 lines 60+ which disclose the overall rec/repr system for recording compressed data with appropriate index information - the recording process is interpreted as meeting the claimed "intermittently" limitation - see for instance the disclosure herein starting at col. 22 lines 40+. This system meets the above noted claimed limitations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M. Psitos whose telephone number is (571) 272-7594. The examiner can normally be reached on M-Thr: 6:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aristotelis M Psitos
Primary Examiner
Art Unit 2627

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